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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/733,441

12/12/2003

Gholam A. Peyman

460-16

2317

1609

7590

11/17/2006

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EXAMINER

THALER, MICHAEL H

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/733,441	PEYMAN, GHOLAM A.	
	Examiner	Art Unit	
	Michael Thaler	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/30/04, 10/1/04</u> . | 6) <input type="checkbox"/> Other: ____ |

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The disclosure is objected to because of the following informalities: Reference numeral 130 (found in [0049]) is absent from the drawings. The reference numeral 126 on the right side of figure 12 is incorrect. In claim 17, line 3, "abut" should be "about". Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 and 18-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 10, line 4, there is no antecedent basis for "said guard member". In claim 18, the reciprocating member defined in line 3 is the same as the first and second arms defined in line 4 (according to the first sentence of [0049]), resulting in a double recitation of the same element.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 11, 15-20, 23, 24, 26 and 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Perez (2003/0220653). Perez, in figure 4A, discloses head portion (the yoke having arms 444 described in [0131] and [0132]) adapted to reciprocate ([0134], [0135] and [0154]) and wire 442. As to claims 5 and 6, Perez discloses positioning member 470 which is affixed to the head portion when they are assembled together. As to claims 7 and 8, the claimed head portion is considered to be the base for arms 444 (at the top right corner of figure 4A) and the guard member is considered to be arms 444. As to claim 9, Perez discloses an upper portion (above slot 490) and a lower portion (below slot 490). As to claims 15 and 17,

Perez discloses blade 500 which forms a groove extending in an arc of 360 degrees which is about 350 degrees since it differs from 350 degrees by only about 2.8 percent.

Claims 10, 12, 14, 21, 22, 25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perez (2003/0220653) in view of Hoffmann et al. (4,662,370). As to claims 10, 21 and 22, Perez fails to disclose slots on opposite sides of positioning member 470 which receive arms on the member having the head portion (i.e. the member having the cutting member). However, Hoffmann et al. teach that the positioning member 11 of a corneal cutter should have slots 111 on opposite sides thereof to receive arms on the member 16 having the head portion (i.e. the member 16 which has the cutting member 17) apparently in order to obtain the advantage of guiding the cutting member precisely along the positioning member 11 (col. 2, lines 32-33). It would have been obvious to include slots on the opposite sides of positioning member 470 of Perez to receive arms on the member (shown in figure 4A of Perez) so that it too would have this advantage. As to claims 12 and 25, Perez fails to disclose a transparent portion that overlies the opening in positioning member 470. However, Hoffmann et al. teach that the positioning member 11 of a corneal cutter should have a transparent portion (22, 27 or 28) that overlies the opening therein in order to

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obtain the advantages of shaping the cornea (col. 3, lines 45-52) while permitting exact positioning of the positioning member 11 (col. 4, lines 17-20). It would have been obvious to include a transparent portion on positioning member 470 of Perez so that it too would have these advantages.

Claims 13 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perez (2003/0220653). Perez fails to disclose the device which produces the oscillations described in ([0134], [0135] and [0154]) as being an electric motor. However, it is old and well known in this art to use an electric motor to produce oscillations since it has the advantage of being a powerful energy source. It would have been obvious to use an electric motor as the device which produces the oscillations of Perez so that it too would have this advantage.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

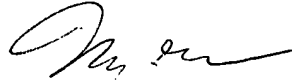
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571) 272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the

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organization where this application or proceeding is assigned is
(571) 273-8300.

.mht



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731